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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,217	10/13/2000	Yoshiaki Tomotake	2000-1428A	3623

7590

07/02/2002

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 07/02/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

MT-4

Office Action Summary

Application No.

09/673,217

Applicant(s)

TOMOTAKE ET AL.

Examiner

Lawrence D Ferguson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed April 18, 2002.
- Claims 1-4 was canceled and new claims 5-8 were added and are pending.

Claim Rejections – 35 USC 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 8, the phrase, "coating applied to such an extent as to not hinder ink absorption" is indefinite. 'Applied to such an extent as to not hinder' does not provide a requisite degree.

Claim Rejections – 35 USC § 102(e)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Suenaga et al (U.S. 6,133,170).

6. Suenaga discloses mercerized pulps (column 7, line 5) having weight percentage in the range from 10 to 100% (column 7, lines 12-13).

Claim Rejections – 35 USC § 103(a)

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

✓ 8. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suenaga et al (U.S. 6,133,170).

9. Suenaga discloses mercerized pulps (column 7, line 5) having weight percentage in the range from 10 to 100% (column 7, lines 12-13). Suenaga discloses coating recording paper and copying paper (column 9, lines 17-26). The reference is silent as to the coating, which is applied for improving ink absorption as per instant claim 7. Since no such coating is disclosed as being applied, the limitation of claim 7 is met. Suenaga does not disclose the liquid transfer length in the Bristow method as being 100 mm or less. The determination of the liquid transfer length by Bristow's method is according to

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J. Tappi No. 51-87 is a product by process limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966. Although the reference does not explicitly disclose ink jet recording paper, one of ordinary skill in the art would commonly use ink jet recording paper, which serves the same function as the copying and recording paper.

Claim Rejections – 35 USC § 102(b)

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated over WO 99/00541.

12. WO '541 teaches ink jet printable paper with fibers (page 1, lines 9-27) with 0 to about 70 percent by weight of mercerized fibers (page 1, lines 36-37).

Claim Rejections – 35 USC § 103(a)

13. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over
✓ WO 99/00541.

14. WO '541 teaches ink jet printable paper with fibers (page 1, lines 9-27) with 0 to about 70 percent by weight of mercerized fibers (page 1, lines 36-37). The reference is silent as to the coating, which is applied for improving ink absorption as per instant claim 7. Since no such coating is disclosed as being applied, the limitation of claim 7 is met. WO '541 does not disclose the liquid transfer length in the Bristow method as being 100 mm or less. The determination of the liquid transfer length by Bristow's method is according to J. Tappi No. 51-87 is a product by process limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966.

Response to Arguments

15. Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Cessna (U.S. 5,853,901) is moot due to grounds of new rejection.

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Arguments made in regards to rejection made under 35 USC 102(b) as being anticipated by Cessna (U.S. 5,853,901) is moot due to grounds of new rejection.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over WO 99/00541 has been considered but is unpersuasive. Applicant argues WO '541 does not teach or suggest that both the high ink absorption speed and high ink coloring density can be obtained by using mercerized pulp in an ink jet recording paper. Applicant's invention does not claim 'high ink coloring density obtained by using mercerized pulp in an ink jet recording paper.' Furthermore the invention is not directed towards the process of obtaining high ink coloring density but is directed towards an ink jet recording paper of mercerized pulp. Applicant argues Bristow's *method* is not a product by process limitation but determines liquid transfer length as an index for representing the property of the water absorbing speed of paper and not a step in a method for producing the ink jet recording paper. The Bristow method is not a part of the article and is directed to 'determining' liquid transfer length, which is a process that leads to the actual article.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

